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IN THE
Supreme Court of the United States

OCTOBER TERM, 1943.

No. 853

PAUL J. BELLAVANCE,
Petitioner,
v.
FRANK MORROW CO., INC.,
Respondent.

**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE FIRST CIRCUIT, AND BRIEF
IN SUPPORT THEREOF.**

HAROLD E. COLE,
Attorney for Plaintiff-Petitioner.

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**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF
APPEALS FOR THE FIRST CIRCUIT.**

TO THE HONORABLE THE CHIEF JUSTICE OF THE UNITED
STATES, AND THE ASSOCIATE JUSTICES OF THE SUPREME
COURT OF THE UNITED STATES:

Your petitioner, Paul J. Bellavance, respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the First Circuit to review the judgment of that court entered February 4, 1944, a petition for rehearing filed thereafter being denied February 24, 1944 and a motion to reconsider the denial of plaintiff's petition for rehearing filed March 3, 1944 being denied with a second opinion March 17, 1944. In the latter opinion the First Circuit Court pointed out the "confusion in the law with respect to the nature of the question of patentable invention" (last page of Opinion) and stated that the United States Supreme Court has by recent cases established two different standards of invention the application of which one depends upon how the case got there, and that the First Circuit will adhere to the strict standard until the confusion in the law is cleared up (p. 3 of Opinion).

Summary and Short Statement.

The issues here are has the United States Supreme Court set up two standards of invention, as the First Circuit Court of Appeals states it has, and if so which standard of invention is applicable to this, and similar patent cases, namely, the strict one set up in *Cuno v. Automatic*, 314 U. S. 84, 91, or the more liberal one towards patents recently set up in *Goodyear v. Ray-O-Vac* (decided February 28, 1944, 60 USPQ 386). Other issues are whether or not the basic law of patents that the burden of proving a patent invalid rests upon the patent's assailant was abrogated by *Cuno v. Automatic*, 314 U. S. 84, and whether or not a federal court may justifiably rely solely upon its own belief of what the prior art and prior knowledge was, unsupported by evidence and upon its belief alone declare a patent invalid, and whether or not a patentee now has the burden of proving his patent valid, and whether or not a district court may ignore the rules of civil procedure and refuse to decide issues before it.

Plaintiff filed suit in the District Court of the United States (Rhode Island) on the Bellavance patent in suit No. 2,108,247 for a Bracelet and Method of Making the same (p. 117) and the Manickas patent No. 2,114,930 for a Bracelet (p. 123). The latter patent covered an improvement in the said bracelet invented and patented by Bellavance. Defendant was charged with infringement of all the claims.

The District Court entered judgment for the defendant, although it made no findings whatsoever on the method claims, which were in issue. The First Circuit Court of Appeals affirmed the District Court, holding all of the claims of the two patents in suit invalid. A Petition for Rehearing was filed February 16, 1944 and denied February 24, 1944, and a motion to reconsider was filed March 3, 1944 and denied with an opinion March 17, 1944.

Two bracelets Exhibits 2 and 5 (Rec. p. 42) were alleged to be an infringement of the article claims of both patents in suit, and the methods used to make the two bracelets were alleged to be an infringement of the three method claims in suit. The District Court judge, other than to include a copy of method claim 2, in its opinion, did not discuss or make any finding whatsoever concerning validity of the method claims. No prior art patents, prior uses or any prior knowledge whatsoever was cited or argued against the method claims. If there exists any prior knowledge in any art of the method that includes an entirely new step of claims 2, 3 and 4 of the Bellavance patent (p. 120) it is not in this record, which includes the file wrapper of said patent, Exhibit O. The vital inventive step Bellavance took was from infinity (no prior art whatsoever) to a new and successful method that produces a new and successful bracelet construction.

The First Circuit Court of Appeals has uprooted a basic law of patents that the burden of proving a patent invalid rests upon the assailant, which law was reiterated in 1937 by Justice Stone in *Smith v. Hall*, 301 U.S. 216, 57 S. Ct. Rep. 711.

When the decision in *Goodyear v. Ray-O-Vac*, (60 USPQ 386) was handed down February 28, 1944 it was called to the attention of the First Circuit Court by a Motion to Reconsider, with the result that its second opinion held that the strict standard of invention set forth in *Cuno v. Automatic*, 314 U.S. 84, 91 was applicable to this case (Second Opinion p. 3) rather than the more liberal standard set up in the later *Goodyear* case, because it was more likely to result in a uniform application of patent law amongst the lower courts (Second Opinion p. 3). If the standard in the *Goodyear* case prevails then the patents in suit are valid, or, at least the method claims are, because all the requirements of a valid patent as set up in the *Goodyear* case are present in the nature of findings of fact with respect to said patents.

Jurisdiction.

This Court has jurisdiction to review the judgment in question under 240-A of the Judicial Code (28 U. S. Code, Sec. 347), and because the First Circuit Court of Appeals has decided a federal question of patent law not in accord with applicable decisions of this court. And because the said First Circuit Court has decided a question of basic law in a patent case in conflict with a decision of the Circuit Court of Appeals for the Second Circuit. See Supreme Court rule 38, (5) (b).

Questions Presented.

The questions presented are whether or not the First Circuit Court is correct in holding that the standard of invention set up in the *Goodyear* case decided February 28, 1944 which is comparatively liberal towards patents is not applicable to this case, and whether or not the standard of invention set up in the *Cuno v. Automatic* case is stricter than in the *Goodyear* case, and if so must and do the claims in suit measure up to it. U. S. Supreme Court rule 38, paragraph 5 (a) and (b).

A further question is whether or not the ultimate question of validity of a patent is a finding of fact or a conclusion of law. If only a finding of fact all courts above the district court are bound by the latter's decision unless clear error appeared, whereas if it is an inference or conclusion drawn from the facts or an ultimate conclusion of law then the appellate courts are free to draw their own inferences or conclusions of fact or law from the subsidiary findings of fact made by the district court. U. S. Supreme Court rule 38, paragraphs 5 (a) and (b).

A further question presented is whether or not the burden of proving a patent invalid has been lifted from the patent's assailant. U. S. Supreme Court rule 38, paragraph 5 (b).

Another question is presented is whether or not a court can rely solely upon its *belief* of what a journeyman in the art would, know thereby providing out of its own imagination an irrelevant argument—not evidence or judicial knowledge—of a patent's invalidity, and if the burden of proving a patent valid is now on the patentee, and if a district court may ignore the Rules of Civil Procedure and refuse to decide issues presented before it and refuse to make findings called for by said rules. U. S. Supreme Court rule 38, paragraph 5 (b).

Reasons Relied Upon for the Allowance of the Writ.

Petitioner believes that this writ of certiorari should be granted in this case for the following reasons and accordingly the discretionary power of this Court is invoked:

That the First Circuit Court is in error in its application of the law as explained in its second opinion of March 17, 1944 that the United States Supreme Court has set up two standards of invention, one strict and one liberal, and that which one is applied to a patent depends upon how the case gets to the Supreme Court, namely, either to resolve a conflict between decisions of two Circuit Courts of Appeals, or to review a decision by only one Circuit Court of Appeals; but if that is correct the Supreme Court should explain and settle upon the application of said standards.

That the First Circuit Court is in error in applying the allegedly strict standard of invention to the patents in suit set forth in *Cuno v. Automatic*, and in declaring the patent claims in issue invalid even on the strict standard.

That the First Circuit Court is in error in not choosing the later and more liberal standard of invention set forth in the *Goodyear* case decided February 28, 1944 and applying that to the patents in suit.

The decisions of the Circuit Courts of Appeals for the First Circuit and Second Circuit are directly in conflict on the question of whether or not a patent can be declared invalid without any evidence of its invalidity or definite judicial knowledge or cognizance of prior knowledge of a method related to the invention. In other words, can a Court examine an invention and declare it invalid merely on its own belief—not upon evidence or judicial cognizance of a fact.

The Second Circuit Court of Appeals held on January 25, 1943 after the case of *Cuno v. Automatic*, *supra*, had been decided by the U. S. Supreme Court, that unless there was some evidence in the record of invalidity that a patent cannot be declared invalid. In that case the patent in suit had previously been held invalid upon established evidence of prior art articles. The patent owner started another suit in the same circuit against another infringer. A motion to dismiss was filed with an argument that the patent was invalid, although there was no evidence of prior art to support the argument. The district court judge granted the motion on the ground that the validity of the patent had been decided adversely in another case in the same circuit. The Circuit Court reversed this decision, because there was no *evidence* of invalidity offered in the case then before it. This was the case of *Gold Seal v. Westerman*, cited January 25, 1943, 56 USPQ 281, 133 F. (2d) 192. The 2nd Circuit judges Swan, Augustus N. Hand and Frank, relied upon the cases of *Smith v. Hall*, 301 U. S. 216, 218, *Lektophone Corp. v. Miller Bros.*, 37 F. (2d) 580, 581 and *Minerals Separation v. Butte & Superior Copper Co.*, 237 F. 401, 402.

In the instant case the First Circuit Court of Appeals stated:

"that the Bellavance method is ingenious and a step forward in the art of making bracelets," (p. 220).

It also stated:

"To be sure Bellavance appears to have been the first one to use the method disclosed in his patent in the art of making bracelets, but in the absence of evidence that the art was waiting impatiently for his contribution we cannot say that invention is unmistakably indicated thereby. It can be said that the Bellavance method is ingenious and a step forward in the art of making bracelets, but in view of the high standard of invention indicated by recent opinions of the Supreme Court (See *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 91, 92), we cannot believe that it is a sufficiently substantial step to warrant the grant of a patent. *Atlantic Works v. Brady*, 107 U. S. 192, 200" (pp. 219, 220).

The Court held that these method claims were invalid because:

"We believe that this is the kind of thing which workmen are accustomed to do almost as a matter of routine and we cannot believe that any uncommon skill was involved in conceiving a vise-like 'jig' such as is disclosed in the Bellavance patent" (p. 219).

The Court offers no clue as to where or how it got its belief that workmen are accustomed to do this almost as a matter of routine. The record shows that those in the bracelet manufacturing business, including defendant's expert, all used the old soldering method to hold the hinge plates to the bracelet sections, and that after learning of Bellavance's method they immediately adopted it.

The *Cuno v. Automatic* case, *supra*, has been a most puzzling one to the Federal Courts and the patent bar. Some courts, such as the First Circuit Court of Appeals, understand that it wiped away the presumption that a patent is valid and "fair upon its face" as Justice Cardozo said in *Radio v. Radio*, 293 U. S. 1, and that a court can declare a patent invalid on nothing more than its belief that it is invalid. Said courts understand that the burden of proof is no longer upon the alleged infringer and that Justice Cardozo's statement that a patent "is presumed to be valid until the presumption has been overcome by convincing evidence of error." in *Radio v. Radio*, *supra*, is not the law now. The First Circuit Court of Appeals has now placed the burden of proving the patent valid upon the patentee. In the instant case, it said:

"To be sure Bellavance appears to have been the first one to use the method disclosed in his patent in the art of making bracelets, *but in the absence of evidence that the art was waiting impatiently for his contribution* we cannot say that invention is unmistakably indicated thereby" (pp. 219, 220).

From now on in the First Circuit the patentee must "unmistakably" indicate invention. The burden is upon him to prove validity, and his patent is *prima facie* invalid it appears, all on account of the case of *Cuno v. Automatic*, *supra*. (The flash of genius test in this latter case was specifically rejected in *Chicago Steel Foundry Co. v. Burnside Steel Foundry Co.*, (C. C. A. 7, 1943) 132 Fed. (2d) 812, 817.

Whether or not the *Cuno v. Automatic*, *supra*, case was intended to make great and fundamental changes in basic patent law is a question that courts and authors have attempted to answer in various ways. The Journal of

the Patent Office Society has had a run of special articles written by authors and patent attorneys in the past 14 months interpreting that decision in conflicting ways. Nowhere did the U. S. Supreme Court say clearly and definitely that the burden of proving a patent invalid is no longer on the patent's assailant. Nor did it say that a court could rely solely upon its belief of what the prior art was to invalidate a patent as not constituting a patentable step forward. In that *Cuno v. Automatic* case there were many prior art patents discussed that were relevant and close to the patented article.

The District Court (Rhode Island) had all of the claims of the patent in this suit before it for decision; yet in defiance of the Rules of Civil Procedure it made no findings whatsoever concerning the method claims and did not say a word to indicate these claims were in issue, except to include a copy of claim 2 in its opinion. When the omission was called to its attention by appropriate motions (Rec. p. 20) it immediately denied them at the close of the oral argument on the motions. Upon the occasion of these motions plaintiff filed three requests for rulings of law (Rec. p. 25) in which he posed the very questions of law now before this court, the first two of which are especially pertinent here: namely:

"1. The burden of proof is on the defendant in a patent infringement suit to show that the patent is invalid. See Walker on Patents under burden of proof and *Radio v. Radio*, 293 U. S. 1."

"2. Since the defendant offered no prior art or other evidence to show that the Bellavance method claims 2, 3 and 4 in suit were invalid, as a matter of law these claims are valid. See *Gold Seal v. Westerman*, 56 U. S. P. Q. Advance sheets page 281, decided January 25, 1943, by the C. C. A. (2nd)" (p. 25).

These requests for rulings of law were denied on April 5, 1943 (Rec. p. 35), and were appealed (pp. 25-26) to the Circuit Court of Appeals for the First Circuit, which affirmed the lower court. Thus it will be seen that the First Circuit Court of Appeals, as well as the district court (Rhode Island), has overturned the long established law that the burden of proving a patent invalid is on the defendant-infringer.

Even if the burden of proving a patent valid has now been put upon the patent owner the Circuit Court of Appeals should give the plaintiff an opportunity to sustain that burden since he had no prior notice of this change in the law and no opportunity to prepare his case with that law in mind.

The refusal of the lower court to act upon the method claims by making findings concerning them is a clear violation of the Rules of Civil Procedure promulgated by this Court which should not be ignored. The handling of this matter by the First Circuit Court in peremptorily holding claims 3 and 4 invalid irrespective of any finding of the lower court, is unjust. It shows how its arbitrary decision that method claim 2 was not proved to be valid by the patentee grew upon it, for it then thoughtlessly concluded that method claim 4, which includes an additional step in the process, is invalid for the same reasons as claim 2.

Prayer.

Wherefore, your petitioner respectfully prays that his petition be granted and for such other and further relief as may be proper.

PAUL J. BELLAVANCE,
By HAROLD E. COLE,
Attorney for Petitioner.





BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

Opinions of the Courts Below.

The opinion of the District Court is found on pages 11-20 of the record and in 49 Fed. Sup. 576. The opinion of the First Circuit Court of Appeals is included in the record sent to this Court (pp. 213, 221), and appears in 60 United States Patents Quarterly, page 311. Its second opinion accompanies the record at the end thereof.

Jurisdiction.

The grounds upon which jurisdiction is invoked is included in the foregoing Petition for Writ of Certiorari. See case of *Goodyear v. Ray-O-Vac*, 60 U. S. P. Q. 386.

The date of the decision to be reviewed is February 4, 1944, and a second opinion of March 17, 1944. A petition for rehearing was filed February 16, 1944 and denied February 24, 1944. A Motion to Reconsider the Denial of Plaintiff's Petition for Rehearing was filed March 3, 1944 and denied March 17, 1944 with an opinion.

Concise Statement.

The material facts necessary to an understanding of the reasons relied upon for allowance of the writ are contained in the foregoing petition.

Argument.

The *Cuno v. Automatic* case, 314 U. S. 84, 62 S. Ct. Rep. 37, with its statement that the new device "must reveal the flash of creative genius" (p. 91) is being used by some

Federal courts as a ground for revamping the fundamentals of patent law, and quite unjustifiably it seems to counsel for petitioner, especially in view of the recent decision and opinion in *Goodyear v. Ray-O-Vac*, *supra*. Not all of the Circuit Courts of Appeals are doing that. The 2nd Circuit Court of Appeals in *Gold Seal v. Westerman*, 133 F. (2d) 192, still insists that the assailant of the patent must furnish the evidence of invalidity of the patent. It does not interpret the *Cuno v. Automatic* case, *supra*, as changing the fundamental law.

The law still prevailing in that circuit was stated by Justice Stone in *Smith v. Hall*, 301 U. S. 216, 57 S. Ct. Rep. 711, who, in discussing prior art evidence, said:

“They support the heavy burden of persuasion which rests upon one who seeks to negative novelty in a patent by showing prior use. See *Radio Corporation of America v. Radio Engineering Laboratories*, 293 U. S. 1, 7, 55 S. Ct. 928, 930, 79 L. Ed. 163, and cases cited.”

Also the *Cuno v. Automatic* flash of genius test was specifically rejected in *Chicago Steel Foundry Co. v. Burnside Steel Foundry Co.* by the C. C. A., 7th Circuit judges in 132 F. (2d) 812, 817.

In the instant case the district court judge had a Request for Ruling of Law presented to him by the patentee and thereupon he specifically denied that the burden of proving a patent is invalid is upon the defendant. That Request for Ruling of Law is on page 25 of the record, and is No. 1. The denial is on page 35. It was appealed from (p. 26), and the lower court was affirmed. Furthermore, the First Circuit Court holds that the method claims of the patent are invalid.

“in the *absence* of evidence that the art was waiting impatiently for his contribution we cannot say that invention is unmistakably indicated thereby” (p. 220).

although it concedes that

“We admit that the idea of supporting thin metal while striking a piece out of its edge was, so far as the record in this case is concerned, new with Bellavance” (p. 219),

and it calls the Bellavance method “ingenious and a step forward in the art of making bracelets” (p. 219).

Not only has the First Circuit Court decided that the burden of proving a patent invalid no longer rests on the assailant, thereof; but also that the patentee has the burden of proving by evidence that the art was waiting impatiently for his contribution. And for its authority for this new and extreme law it cites *Cuno v. Automatic*, *supra*.

What is the law? Is the Second Circuit right in holding a patent must be proved invalid by evidence or is the First Circuit right that no evidence or judicial knowledge is required to hold a patent invalid, and that the burden of proving validity rests upon the patentee himself.

Tremendous confusion has resulted from this decision and from the various interpretations placed upon the *Cuno v. Automatic* case, *supra*. Law magazines and the Journal of the Patent Office Society have printed article after article, discussing the *Cuno v. Automatic* case, the authors drawing radically different conclusions therefrom. The second opinion of the First Circuit Court of Appeals in the instant case is still another view of that case and said First Circuit Court admittedly finds itself confused.

On January 18, 1944 in the case of *Potts, et al. v. Coe*, Com'r. of Patents, 60 U. S. P. Q. 226, Advance Sheets, Judges Thurman Arnold and Miller of the Court of Appeals, District of Columbia, held that the burden of proof of patentability is on applicant and that the applicant's oath is no longer a *prima facie* showing of invention even if an article is novel. On page 233 they said:

“The burden of proof of patentability is on the applicant. Prior to the development of corporate research the circumstances under which the alleged invention was made were ordinarily not examined. The oath of the applicant was considered as a sufficient *prima facie* showing of invention provided the article itself was sufficiently novel.”

The case of *Cuno v. Automatic, supra*, is cited in support of this new law concerning invention (p. 229). Is this change in the law authorized? It is similar to the change that the First Circuit Court of Appeals has made in the instant case concerning a patent, namely, thrown upon the patentee the burden of proving his patent is valid. Even though the invention is “ingenious and a step forward” (Opinion p. 220) as the Circuit Court said in this case, still it is invalid until proved valid by “evidence that the art was waiting impatiently” for the patentee’s invention (p. 220).

“Ingenious” means, according to Funk & Wagnalls College Standard Dictionary:

“Possessed of or manifesting inventive faculty.” Here we have a situation where a method is inventive, that is, “ingenious”; but not patentable. Is the law to continue to be that harsh? Shall every lower court’s hand be turned against the patentee inventor?

The First Circuit Court of Appeals has fabricated the prior art from its *belief* alone. It conceives, in its imagination, a journeyman who would think to do what the patentee Bellavance did, although this is just what the journeyman in the jewelry field failed to do. When did their journeyman become so skilled? Under the statute the patentee is entitled to know that date and he has a right to carry the date of his invention back of the filing date. This statute is U. S. Code, title 35, section 69, reading as follows:

“And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used.”

Mr. Bellavance can carry his date of conception of his method back of his filing date, and since he is not a manufacturer himself he isn't limited by any statutory bar of public use in proving an early date.

This goes to show how unfair and unlawful it is for the First Circuit Court to rely on what it imagines a journeyman would do without giving the patentee the date such a journeyman existed. It deprives the patentee of his chance under the law, as stated in Walker on Patents, 6th edition, section 553:

“But the plaintiff may meet the defendant's evidence of anticipating matter by proof that he, or his assignor, made the invention at a still earlier date.”

There are statements in the First Circuit Court's opinion that are incorrect, and these should be noted. First of all there is more to the patented method as set forth in claims 2, 3 and 4 of the Bellavance patent (pp. 120, 121), than merely “supporting the lateral faces of said flanges at points adjacent to the struck down portions” (Rec. p. 219). The claim is specific. Claim 2, which the court discusses in detail, is confined to a method of forming a bracelet structure, and to the steps of shaping metal stock to form a curved section having lateral flanges, fitting a portion of a holding member between the lateral flanges adjacent to an end portion of said section, and striking down portions of the lateral flanges upon the part

of said holding member fitted between the flanges to clamp said holding member to said section. This latter step is entirely new in bracelet manufacture. Heretofore the holding or hinge member was held in place in the bracelet section by soldering and the district court so found (pp. 13, 17). Bellavance conceived and applied to the foregoing steps the idea of supporting the lateral faces of the flanges at points adjacent the struck down portions. This made it possible to swage portions of the flanges onto the holding members or hinge plates. Heretofore, when this form of swaging had been practiced in other arts the metal was thick and strong enough to stand alone and absorb the force of the swaging action. But in bracelets a thin metal is used, hence the method disclosed in the Hiering patent (p. 195) is not applicable to bracelets because it would distort them.

So for many years bracelets were made by millions, and the hinge plates were soldered in place for lack of any method for striking lugs out of the flanges onto said plates that would not deform the bracelet section. Once the new method was invented and applied to bracelets, everybody could see that it was easy to do. That is always true of the greatest inventions. As the U. S. Supreme Court said in *Loom Co. v. Higgins*, 105 U. S. 580, page 591:

“But it is plain from the evidence, and from the very fact that it was not sooner adopted and used, that it did not for years occur in this light to even the most skillful persons. It may have been under their very eyes, they may almost be said to have stumbled over it, but they certainly failed to see it, to estimate its value, and to bring it into notice. Who was the first to see it, to understand its value, to give it shape and form, to bring it into notice and urge its adoption, is a question to which we shall

shortly give our attention. At this point we are constrained to say that we cannot yield our assent to the arguments, that the combination of the different parts or elements for attaining the object in view was so obvious as to merit no title to invention. Now that it has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit."

The laws of mechanics and science remain steadfast. Every thing does just what you would expect it to once you understand it and see how some one else has applied the knowledge. The First Circuit Court of Appeals now says that:

"we have grave difficulty in seeing how it could possibly be said that an exercise of the faculty of invention was required to conceive the idea" (p. 219).

Let us learn from those who were skilled in the art and were actually making bracelets and gained their livelihood therefrom, because these are the skilled journeyman who have the greatest stimulus to find a better way of making bracelets.

That the art was longing for Bellavance's invention and was trying to solve the problem it was confronted with, is evidenced by the large number of prior art patents for bracelets in evidence. First of all we have the finding of the district court that:

"Hargreaves admitted in cross-examination that up to 1937, the common way of attaching the hinge plate to the bracelet was by soldering" (Rec. p. 17).

Who was Hargreaves? He is a bracelet manufacturer, and has been an expert particularly in bracelet manufacture for 35 years (Rec. p. 15). In trying to solve the

problem Hargreaves in 1933 invented and patented a bracelet himself (Rec. p. 179). He failed, for he admitted that the practice was to solder the hinge plate to the bracelet up to 1937 when Bellavance made his invention. Here was a "journeyman" and more, for he was an inventor himself, highly skilled in the art, and devoting his time and talents to the very same problem Bellavance did, namely, to eliminate soldering of the hinge plates to the bracelet sections.

Take the Morrow brothers, two officers of defendant corporation. Both Earl Morrow and his brother Frank Morrow are experts in bracelet manufacture. Earl Morrow devised the Exhibit 2 bracelet in an effort to avoid infringement of the article claims of the patents in suit and sought a patent therefor (Rec. p. 62). Their testimony shows they are fully acquainted with all phases of the manufacture of bracelets, shop practices, etc.

Furthermore, they were under the greatest stimulus to find a way of making a better bracelet because they are the largest bracelet manufacturers in this part of the country at least, and thus had the most to gain by devising a better method to take the place of soldering the hinge plates to the bracelet sections. They were unable to overcome the problem; but did change over to Bellavance's method and adopt his bracelet construction with alacrity immediately upon learning of them.

The statement in the opinion (Rec. pp. 218, 219) that there can be no doubt that the district court found claim 2 invalid is erroneous. There is no indication anywhere that the Court considered the Bellavance method at all. Claim 2 was copied into the lower court's opinion, and thereafter it was never mentioned. There is no discussion whatsoever of the Bellavance method. Nothing is said in the opinion to indicate that the district court judge had it in mind. His closing statement that "the Bellavance and Manickas bracelets are not patentable" shows that he dealt only with the article claims for the bracelets.

To allow a district court judge to ignore the Rules of Civil Procedure as the district court judge has done in this case is to flout them. Those rules were made by the United States Supreme Court and the Circuit Courts of Appeals should uphold them—not permit outright violations of them.

The First Circuit Court in its second opinion frankly states that it and the district court heavily relied upon *Cuno v. Automatic* in concluding that the claims of the plaintiff's patents were invalid for lack of invention (Opinion p. 2). It believes that the Supreme Court in the *Goodyear* case did not recede "from the strict application of the standard for invention established in the *Cuno* case" (Opinion p. 3). This, in its opinion, leaves the law such that if a patent case reaches the Supreme Court to resolve a conflict between decisions of two Circuit Courts the Supreme Court "will apply the standard strictly" (Opinion p. 3). But if the case reaches the Supreme Court merely to review a single decision by a Circuit Court of Appeals, as in the *Goodyear* case, that held a patent valid, it will apply the standard of invention liberally. This is most unfair to a patentee. As the First Circuit Court says in this case (second opinion):

"The situation may be unfortunate in that it leads to the unequal application of the patent law—a relatively trifling contribution may eventually obtain the protection of a patent while a more important one may not, depending upon whether or not there is a conflict of view between circuits—but this is not a problem for us to cope with" (Opinion p. 3).

The First Circuit Court then goes on to say:

"The most that circuit courts of appeals and district courts can do is what we and the court below

have done here, that is, apply to the best of our ability the standard as we think the Supreme Court would apply it if a conflict between circuits should arise and certiorari should for the reason be granted" (Opinion p. 3).

In other words, the allegedly strict standard of the *Cuno* case has been applied to this case rather than the liberal standard of the *Goodyear* case. This leaves the patentee and the courts in a confusing predicament which only the Supreme Court can clear up, and on the question of validity leaves every one in a state of uncertainty which the First Circuit Court describes as

"the confusion in the law with respect to the nature of the question of patentable invention" (Opinion p. 4).

Counsel for petitioner believes that such findings as the existence of prior use, commercial success, the conscious copying of a patented article, et cetera, insofar as they depend upon oral testimony or upon conflicting testimony are findings of fact that are not reversible except for manifest error. But if the evidence is documentary or in the form of records the appellate court is in the same position as the lower court and fully able to draw its own conclusions therefrom unaffected by those of the lower court. See *Amory v. Amherst College*, 229 Mass. 374, 389, 390.

Any inferences or conclusions drawn from findings of fact are subject to review by the Supreme Court and by a Circuit Court of Appeals. The lower court judge is in no better position to draw conclusions from the facts as to validity than higher courts. As stated by Judge Lummus, now of the Massachusetts Supreme Judicial Court, in discussing findings of fact and conclusions of law in the Massachusetts Superior Court Rules, Rule 90, page 288:

"where the master reports the subsidiary facts and then draws a conclusion from them * * * it is the duty of the judge to draw proper inferences from the findings unaffected by the conclusions of the master and the duty of the full court to draw such inferences unaffected by the conclusions of either." *Robinson v. Pero*, 272 Mass. 482, *Brockton v. Lee*, 266 Mass. 550, 562.

In *United States v. Robert Esnault-Pelterie*, 299 U. S. 201, 205, Justice Butler held that decision on the issues of validity and infringement depends upon findings of fact, and that on these issues:

"the findings in order to be sufficient to sustain judgment for plaintiff must specifically decide questions of validity and infringement, and also include circumstantial facts sufficient to warrant the court's conclusion in respect to the main issues."

In cases tried without a jury the court can always review conclusions drawn from findings of fact. This has always been the law. Unless it can an appellate court is practically powerless.

In the instant case the District Court and the Circuit Court of Appeals have found facts which inexorably lead to the conclusion that the claims in suit are valid if the law laid down in the *Goodyear* case is applied.

The Bellavance method in this case, like the Anthony dry cell in the *Goodyear* case was invented in an old art that was devoid of any solution for the difficulties that their inventions overcame. Once the inventions became known they commended themselves to the public as evidenced by their marked commercial success.

The Circuit Court of Appeals concedes in its opinion that the Bellavance method was new, that he was the

first to use the method in bracelet making, and that it is ingenious and a step forward in the art of making bracelets. Where it errs is in holding the patents invalid because a journeyman or workmen should have discovered and done it as a matter of routine. As Justice Roberts said in the *Goodyear* case:

“Viewed after the event, the means Anthony adopted seem simple and such as should have been obvious to those who worked in the field, *but this is not enough to negative invention.*”

Since the Supreme Court has said that even though the invention should have been obvious to the skilled workmen when viewed after the event, “this is not enough to negative invention”. The First Circuit Court should be guided thereby rather than interpreting the *Cuno* case as setting up a different and strict standard of invention which the lower courts should adhere to.

The Article Claims in Suit.

Coming to the Bellavance article claim 1. It is specific to a bracelet structure, and to a certain kind of bracelet structure, which is made of material that cannot be swaged as Hiering swaged. If it were made of material comparable in thickness with that Hiering used to make a bag frame then the court's finding that the arts are sufficiently analogous to one another to negative invention by Bellavance would have more weight (Rec. p. 218). But the situation is not that. The Bellavance bracelet structure is the product of his new “ingenious and a step forward” method. It is restricted to the product of that method in a practical sense. To adequately protect a method invention the article produced thereby, if it is new, should likewise be protected. Such has been the custom.

The Bellavance bracelet is a new one—a product resulting from the creation of his new method.—In all fairness to an inventor who has so advanced the art, patent protection for an article should go along with that for a method if it is possible, and in this case it is because claim 1 is so specific as to structure.

The above also holds true as to the claims of the Manickas patent (p. 123), since Manickas advanced the art by inventing a structure that gives greater strength to the bracelet. It is not asserted that the difference between what Manickas did and what Bellavance did in conceiving his new method are equally great. The step Bellavance took was from infinity to a method because there is no analogous method step in evidence prior thereto. What Manickas did was to extend the existing flanges—not shape them differently as the Court said on page 218 of its Opinion—and to apply his idea to a certain bracelet structure that he claimed.

Public Interest.

In the United States inventors and scientists are our most important citizens. Without them we could not win this war, for enemy nations have successfully stimulated their inventors to improve upon the apparatus and devices of warfare. Scientific workers and inventors are the creators of the improvements in life which we call material progress. Every one benefits from them. The growing hostility of courts toward their patents originally started in decisions against those who abuse the patent monopoly by using invalid patents in attempts to legalize violations of the Sherman-anti-trust Act. But the lower courts, such as the First Circuit Court of Appeals in this case, have now turned against inventors and their patents. They are mutilating the patent statute enacted by Congress and all the law that was developed by the courts under it.

The Government grants inventors a patent monopoly as a reward for inventing and disclosing their inventions. The Constitution authorizes it and Congress has enacted the patent statute, which has not been changed in a material sense for many years. The courts can at least lay down clear laws for these men of progress. If new burdens are to be laid upon their inventions and old protections removed, the law should be the same in every circuit. The basic rules of evidence should be the same throughout the United States on such vital issues as proving patent validity or invalidity. The standard of invention should be the same in all circuits.

Conclusion.

Counsel for plaintiff-petitioner earnestly submits that this Court should order up this case to resolve the confusion in the law; settle upon basic principles of burden of proof in patent law, clear up the question of what standard of invention should be applied to a patent (strict or liberal), whether the ultimate questions of validity and infringement are conclusions of law, findings of fact, or inferences or conclusions from findings of fact and to what extent said ultimate questions are reviewable by Circuit Courts of Appeals.

Respectfully submitted,

HAROLD E. COLE,
Attorney for Plaintiff-Petitioner.



17
IN THE

Supreme Court of the United States

OCTOBER TERM, 1943.

No. 853

PAUL J. BELLEVANCE,

Petitioner,

v.

FRANK MORROW CO., INC.,

Respondent.

**BRIEF IN OPPOSITION TO PETITION
FOR WRIT OF CERTIORARI.**

NATHANIEL FRUCHT,
Attorney for Respondent.

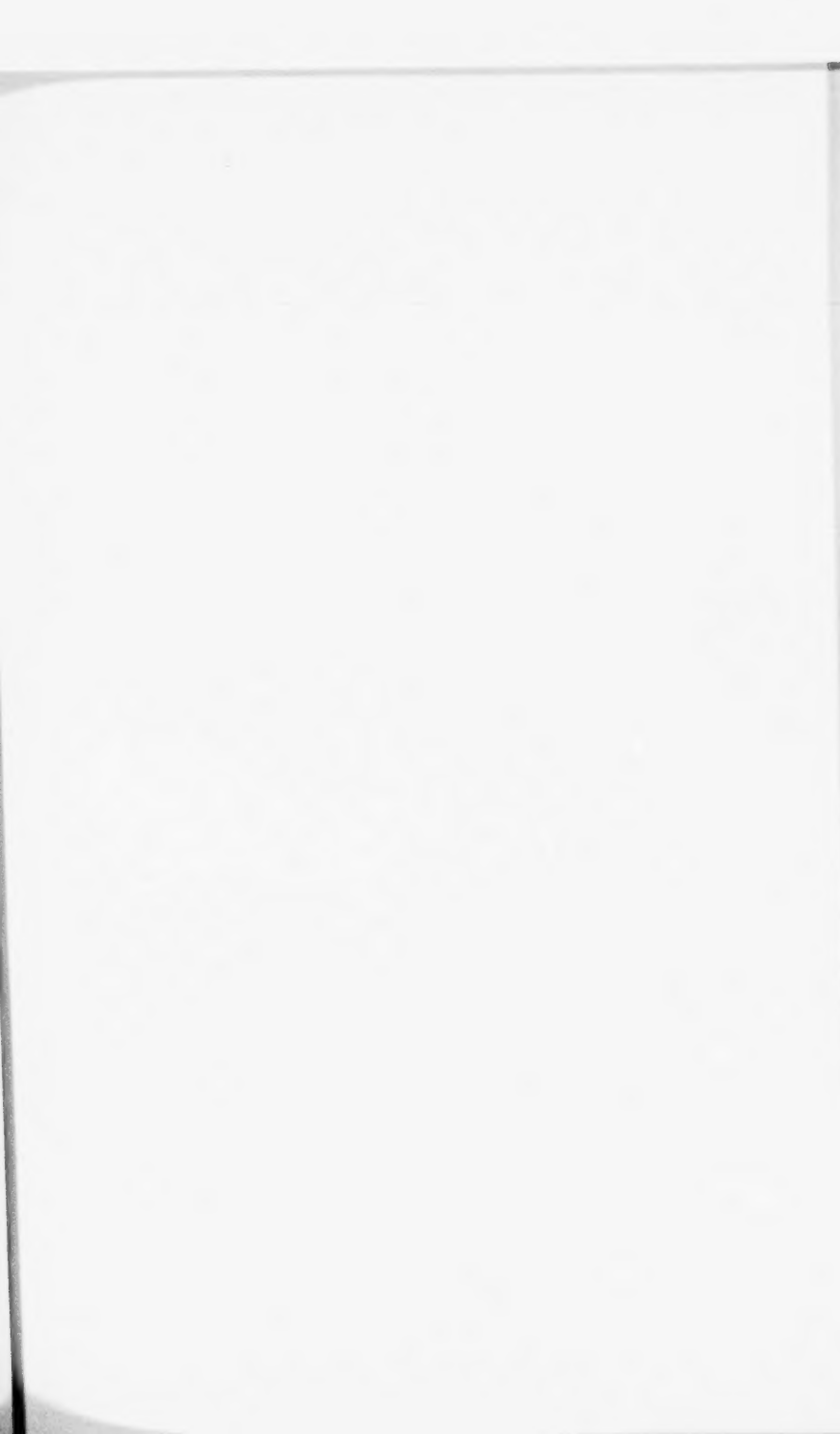


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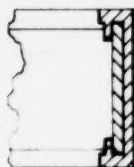
BELLAVANCE PATENT
NO. 2,108,247

Fig. 4



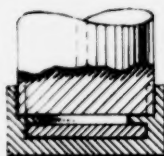
MANICKAS PATENT
NO. 2,114,930

Fig. 5



HIERING PATENT
NO. 1,996,109

Fig. 3



IN THE

Supreme Court of the United States

OCTOBER TERM, 1943.

No.

PAUL J. BELLAVANCE,	} Petition for Writ of Certiorari
<i>Petitioner,</i>	
<i>v.</i>	
FRANK MORROW CO., INC.,	
<i>Respondent.</i>	

BRIEF IN OPPOSITION ON BEHALF OF RESPONDENT

I.

The Character of the Suit.

The petitioner is the owner of two patents, Bellavance No. 2,108,247 patented February 15, 1938 and Manickas No. 2,114,930 patented April 19, 1938, for improvements in bracelet constructions. The defendant is a manufacturer of jewelry bracelets which are alleged to be infringements of these patents.

The patents in suit relate to the construction of a bracelet to be worn on a lady's wrist. The particular type of bracelet is made in two sections, which are curved and have side flanges, and are hinged together; the free ends of the two sections are

provided with catch and latch connections so that the bracelet may be opened for positioning on the wrist and then snapped shut for retention on the wrist.

The hinge construction for bracelets of this type is commonly made separately, in the form of two plates hinged together; these plates were for many years inserted into the section ends between the flanges and soldered in place.

Instead of using solder, Bellavance inserted his hinge plates tightly between the flanges so as to abut the flanges, and then used a punch to strike the inner walls of the flanges and punch down pieces of metal (called lugs) from the interior of the flange walls to contact with and grip the plates. This is the essence of the subject matter of Claims 1 and 2 of Bellavance. Since Bellavance used bracelet sections of thin stock having straight-sided flanges, he believed it necessary to prevent buckling of the flanges during the punching operation, and therefore provided a support for the flange walls. The supporting of the flange walls during the punching operation of striking down the lug is the essence of Claims 2, 3 and 4 of Bellavance.

Manickas utilized another type of bracelet section. Instead of straight-sided walls, his bracelet sections have flanges which extend upwardly and then inwardly to form what he calls a "channel shaped flange". The hinge plates are pushed under the inturned flange ends, and then, just as in Bellavance, pieces of metal (lugs) are punched out of the stock of the inturned flange edges onto the hinge plate to lock it in place. This is the essence of Claims 1 and 2 of the Manickas patent.

II.

The Prior Art.

The District Court of Rhode Island and the First Circuit Court of Appeals considered the evidence of prior use and prior knowledge presented by the defendant, and particularly the Hierung patent No. 1,996,109. As stated in the opinion of the Court of Appeals, (p. 217), this patent

"discloses a metal frame for women's hand bags made out of thin, channel shaped stock and having mitered corners reinforced by a flat angle-iron inserted between the flanges or side walls and gripped securely in place by what the patentee calls 'tabs' (it is evident from the drawings that 'tabs' are identical with what are called 'lugs' in the plaintiff's patents), struck out of the inner surfaces of the flanges."

The Hiering patent, which is prior to both the patents in suit, thus discloses both an article of manufacture and a method, in which a plate element is gripped between the flanges of a channel member by striking down lugs from the inner walls of the flanges to engage the plate element.

In addition to the Hiering patent many other patents dating back to 1880 were introduced in evidence and were considered by the Court, (p. 14), as well as bracelets which were manufactured and sold by bracelet manufacturers prior to the inventions of the patents in suit, and which also utilize lugs struck down from the flanges of the bracelet channel sections to lock the hinge plates in place. (pp. 15, 16).

III.

The Decision of the District Court.

After consideration of the evidence introduced the District Court made its findings:

1. That the claims of both patents in suit are fully anticipated by the prior art and particularly by the disclosure of the Hiering patent (p. 17).
2. That the Bellavance and Manickas bracelets are not the result of invention as distinguished from mere mechanical skill possessed by those skilled in the art to which they appertain (p. 17).
3. That the Bellavance and Manickas bracelets are not patentable (p. 20).
4. That both patents in suit are invalid (p. 17).

IV.

The Decision of the Circuit Court of Appeals.

The plaintiff having appealed, the First Circuit Court of Appeals reviewed the findings in the light of the evidence submitted and affirmed the judgment, Judge Woodbury stating:

"It seems to us clear that all of these claims (the article claims) are anticipated by the prior art, particularly by the Hiering patent (No. 1,996,109) upon which the court below principally relied." (p. 217).

"Claim 2 is the plaintiff's generic method claim. It covers striking down a portion of the lateral flanges 'while supporting the lateral faces of said flanges at points adjacent to the struck down portions'. This quoted phrase contains the crux of the plaintiff's method. He says that without support the flange of bracelet stock, being necessarily thin, would crumple or collapse when struck by a punch or die for the purpose of striking a lug out of it, and that to think of supporting it to prevent its crumpling was not only new but also called for an exercise of the inventive faculty. We admit that the idea of supporting thin metal while striking a piece out of its edge was, so far as the record in this case is concerned,³ new with Bellavance, but we have grave difficulty in seeing how it could possibly be said that an exercise of the faculty of invention was required to conceive the idea. Making full allowance for the fact that a new technique may seem obvious only after someone else has thought of it, still it seems to us too clear for argument that any journeyman who discovered that a piece of thin metal collapsed or crumpled when he struck it on the edge would at once think of the expedient of supporting it at points adjacent to the place where he desired to strike it. We believe that this is the kind of thing which workmen are accustomed to do almost as a matter of routine and we cannot believe that any uncommon skill was involved in conceiving a vise-like 'jig' such as is disclosed in the Bellavance patent." (pp. 218, 219).

³Hiering used heavier stock for his bag frames than is used in making bracelets and apparently he did not need to support it when striking down his "tabs".

The plaintiff, thereafter, filed a petition for rehearing which was denied February 24, 1944, and subsequently filed a motion to reconsider the denial of the petition for rehearing, which motion was denied March 17, 1944. The plaintiff thereupon filed his petition for issuance of a writ of *certiorari*.

V.

Argument.

In his brief the petitioner urges the following reasons for allowance of the writ of *certiorari*.

1. The decision of the First Circuit Court of Appeals is in conflict with the law announced by the U. S. Supreme Court in *Goodyear v. Ray-O-Vac Co.*, (1944), 64 S. Ct. 593.

2. The decision of the First Circuit Court of Appeals is in conflict with the decision of the Second Circuit Court of Appeals in *Gold Seal v. Westerman* (1943), 133 F. (2) 192.

Either of these conflicts would furnish appropriate grounds for a review under the provisions of Sec. 240 A of the Judicial Code (28 U. S. Code, Sec. 347) and U. S. Supreme Court Rule 38, (5) (b).

The respondent argues that neither of these conflicts exist.

1. *The decision in the instant case is consistent with the law announced in the Goodyear case.*

The law of patentability as it pertains to the instant case is clearly and fully set forth in Judge Hartigan's opinion (pp. 17, 18, 19) in which the court relied on *Atlantic Works v. Brady*, 107 U. S. 192, *Jaite-Grant Display Bag Company v. Thomas M. Royal & Co.*, 27 F. Supp. 251, 252, *Altoona Theatres v. Tri-Ergon Corp.*, 294 U. S. 477, 486, and *Cuno Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 91 and 92. Applying the rule of law as laid down in the *Cuno Corp.* case to the facts in the instant case, namely,

"that a new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling",

Judge Hartigan found that the constructions of the patents in issue were not patentable.

The situation in the *Goodyear* case, cited by the petitioner, is not analogous to and does not accord with the facts in the instant case. In the *Goodyear* case the District Court considered the evidence and found that although the problem was an old problem in the art no solution had been obtained prior to the invention in issue; wherefore the District Court found the claims of the patent in suit valid. The Seventh Circuit Court of Appeals reexamined the findings in the light of the evidence submitted and accepted them. The United States Supreme Court refused to set aside the concurrent findings of the two lower courts because

"it must be a strong case to set aside the concurrent findings of two courts".

That the *Goodyear* case is not in conflict with the *Cuno Corp.* case and does not liberalize the legal standards for invention is recognized in the opinion of the First Circuit Court of Appeals on the Motion to Reconsider Denial of Plaintiff's Petition for Rehearing (p. 222). Judge Woodbury stated:

"In the *Goodyear* case, however, the Supreme Court did not grant *certiorari* to resolve conflicting decisions below, but granted the writ to review an affirmance by the Circuit Court of Appeals for the Seventh Circuit of a district court decree holding certain claims of a patent valid and infringed. In this situation a majority of the court decided that the case was not strong enough to justify setting aside the concurrent findings of the two courts, district and circuit [fol. 225] court of appeals, to the effect that the claims in suit were valid in that they disclosed an exercise of the faculty of invention. What it did in the *Goodyear* case, therefore, does not indicate that it is receding from the strict application of the standard for invention established in the *Cuno* case, which was not mentioned in the *Goodyear* opinion."

It is therefore submitted that the *Goodyear* case does not modify or change the legal standards for invention defined in the *Cuno Corp. v. Automatic* case.

2. *The question decided by the Second Circuit Court of Appeals in Gold Seal v. Westerman bears no relation to any question presented or decided in the instant case, nor does it deal with any question peculiar to patent law.*

In the instant case the Circuit Court of Appeals, as also the District Court, considered the evidence adduced by both parties and both courts found the facts determining invention and validity against the plaintiff.

There was no submitted evidence and no findings of facts determining invention and validity in the *Gold Seal* case relied on by the petitioner.

In the *Gold Seal* case the Circuit Court of Appeals had before it only the ruling of the District Court upon a motion to dismiss on the ground that the issues in the case were *res adjudicata*. The defense was on appeal held bad, on the simple ground that the defendant was not a party to the previous suit or in privity with the previous defendant. The decision thus pertains to a question of repetitive litigation, and does not set forth any doctrine which is peculiar to patent law, nor does it change or modify the patent law relating to novelty and invention as set forth in *Cuno Corp. v. Automatic* and in *Hollister v. Benedict Mfg. Co.*, 113 U. S. 59 at pages 70, 71 and 72.

VI.

Conclusion.

The District Court and the First Circuit Court of Appeals both reviewed the evidence presented in this case, and both found the claims of the Bellavance patent and the Manickas patent in suit invalid. The decisions of the two courts were thus concurrent.

The *Goodyear* decision relied on by the petitioner as being in conflict with the decision of the First Circuit Court of Appeals is, as stated above, not in conflict, and neither modifies nor liberalizes the legal standards for invention defined in *Cuno Corp. v. Automatic* case; nor does the *Gold Seal v. Westerman* case relied on by the petitioner conflict with the decision of the

First Circuit Court of Appeals in the present case.

The petition for a writ of *certiorari* should therefore be denied.

Respectfully submitted,

NATHANIEL FRUCHT,
Attorney for Respondent
1023 Hospital Trust Bldg.,
Providence, R. I.





JUN 9 1944

CHARLES ELMORE DUFFLEY
CLERK

IN THE
Supreme Court of the United States

OCTOBER TERM, 1943

PAUL J. BELLAVANCE,
Petitioner,

v.

FRANK MORROW CO., INC.,
Respondent.

No. 853

PETITION FOR REHEARING.

TO THE HONORABLE, THE CHIEF JUSTICE AND ASSOCIATE
JUSTICES OF THE SUPREME COURT OF THE UNITED STATES

Statement.

This is a suit brought by petitioner against respondent for infringement of the claims of his two patents. The Circuit Court of Appeals for the First Circuit affirmed the judgment of the district court declaring the claims of the two patents in suit invalid. A petition for certiorari was filed April 6, 1944 and was denied May 15, 1944.

A rehearing is herewith petitioned for from the decision dismissing the petition for certiorari.

Grounds for Rehearing.

The First Circuit Court of Appeals in its opinion stated in its second Opinion in this case (Rec. p. 221):

p. 223 "we see no reason here to do more than advert again to the confusion in the law with respect to the nature of the question of patentable invention."

It must be that this Court overlooked this closing statement in the First Circuit Court's opinion that it finds the law as laid down by the U. S. Supreme Court is confused at present. Previously in said second Opinion the First Circuit Court explained why it found the law confusing, namely, because the U. S. Supreme Court has established two standards of invention.

In the Rules of the U. S. Supreme Court, No. 38, are given the reasons for granting a review on writ of certiorari, among which are

5 (b) "or has decided an important question of federal law which has not been, but should be, settled by this court;"

Certainly the standard of invention which determines the validity of a patent is an important question of federal law—one which ten Circuit Courts of Appeals and many more District Courts below them, are constantly dealing with. This question of federal law, namely, the standard of patentable invention, is unsettled, and the First Circuit Court said so in so many words. Obviously, it should be settled by this Court.

The reality of the present situation is this. The U. S. Supreme Court does and has set the standard of invention in the eyes of several Circuit Courts of Appeals and

District Courts below them. The first Circuit Court acknowledges this and follows the strict standard it interprets was set in the *Cuno Engineering Corp. v. Automatic Devices Corp.* case, 314 U.S. 84, 91, 92, and on page 219 of the Record it said:

“It can be said that the Bellavance method is ingenious and a step forward in the art of making bracelets, but in view of the high standard of invention indicated by recent opinions of the Supreme Court (see *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 91, 92), we cannot believe that it is a sufficiently substantial step to warrant the grant of a patent.”

Here is one Circuit Court that explicitly says that it follows the standard of invention of the U. S. Supreme Court set up in the *Cuno* case, *supra*. (See Rec. p. 223 also.)

The 2nd Circuit Court of Appeals has likewise adopted the standard of invention set up by the U. S. Supreme Court. See *Picard v. United Aircraft Corp.*, 128 F. 2d 632, 53 USPQ 563, wherein the 2nd Circuit Court said that the Supreme Court's word is final in setting the standard of invention. Other Circuit Courts also have adopted the standard of the U. S. Supreme Court; but not all.

On the other hand the 7th Circuit Court of Appeals does not recognize the standard of invention set up by the U. S. Supreme Court in the *Cuno* case, *supra*, and specifically said so in *Chicago Steel Foundry Co. v. Burnside Steel Foundry Co.*, 132 Fed. (2d) 812, 817. The standard of the 7th Circuit is obviously lower than in the First and Second Circuits, as is clearly apparent from its decision in *Ray-O-Vac Company v. The Goodyear Tire & Rubber Co.*, holding claims to a leakproof dry cell for batteries valid and infringed, which decision was affirmed

by the U. S. Supreme Court on February 28, 1944, 60 USPQ 386. Plaintiff-petitioner's method claims are clearly valid by the standard set in this *Ray-O-Vac* case.

In a decision released May 10, 1944 by the Court of Customs and Patent Appeals, 61 USPQ 362, 31 C. C. P. A. (Patents), that Court stated that it would not follow the "flash of genius" standard of invention set up in the *Cuno* case, *supra*, but would follow the long line of U. S. Supreme Court decisions that previously decided what the standard of patentable invention is. In discussing the *Cuno* case and its "flash of creative genius" term it said:

p. 367, USPQ:

"While recognizing, of course, that it is the duty of this court to follow the law as declared by the Supreme Court, we do not conceive it to be our duty to change our basis of decision merely because some courts assume that there is a 'new doctrinal trend' with regard to the standards required for invention.

"In our opinion it is not within the province of the courts to establish new standards by which invention is to be determined. It seems clear to us that the creation of new standards for the determination of what constitutes invention would be judicial legislation and not judicial interpretation."

But another appellate court that passes upon the patentability of inventions, which has concurrent jurisdiction with the Court of Customs and Patent Appeals on the question of the right of an inventor to be granted a patent, namely, the Court of Appeals, District of Columbia, in 60 USPQ 226, in the recent case of *Potic, et al. v. Coe*, decided that the law has been changed, and cited the *Cuno* case, *supra*, in support of its contention of said change.

Instances could be multiplied where courts that pass upon the validity of patents already issued, and upon the right of inventors to be granted patents, are taking opposite stands on the question of what constitutes patentable invention. This confusion resulted mostly from the *Cuno* case, *supra*, and its "flash of creative genius" term. It is a fact that the law of what constitutes patentable invention is, at present, uncertain and in confusion, and the statement by the First Circuit Court of Appeals in its second opinion in this case clearly described the situation as follows:

Record p. 223. "The situation may be unfortunate in that it leads to the unequal application of the patent law—a relatively trifling contribution may eventually obtain the protection of a patent while a more important one may not, depending upon whether or not there is a conflict of view between circuits—but this is not a problem for us to cope with."

The "problem" is one for the U. S. Supreme Court to cope with, and the time to do it is now, since the instant case presents the opportunity, having been decided on its interpretation that the *Cuno* case, *supra*, set a new and higher standard of invention which the First Circuit Court follows (Rec. p. 223, 2nd opinion).

As the law now stands, in the 7th Circuit for instance, the standard of patentable invention is relatively low, and a patent such as the dry battery cell enclosed in a metal jacket is valid in that Circuit; but would not be in the First Circuit where the Court in its second opinion acknowledged that the method claims of the patent in suit covered an ingenious and successful invention. In other words the First Circuit Court accepts the standard of invention set up in *Cuno v. Automatic*, *supra*, and inventors lose patent rights to valuable inventions there,

while the Seventh Circuit Court does not accept said standard of the *Cuno* case, *supra*, with the result that inventors can successfully maintain their rights against infringers of their patents. Validity depends upon venue.

Obviously this is an unsettled situation which the U. S. Supreme Court should settle. While the *Cuno* case, *supra*, has not been cited in opinions of the U. S. Supreme Court for some time now; neither has it been overruled, and it has left every one guessing and groping and adopting various standards of inventions.

Consider the uncertainty thus created for the inventor who applies for a patent. If he appeals to the Court of Appeals for the District of Columbia, its standard is based on the *Cuno* case, *supra*, and its interpretation of the "flash of creative genius" term, and it is almost certain that he will be denied a patent for his invention. But if he appeals to the Court of Customs and Patent Appeals, his prospect of obtaining a patent are much better because that Court has specifically said that it will not acknowledge the *Cuno* case, *supra*, as setting forth a new standard of patentable invention, and that it will follow the old line of decisions.

The present chaotic situation cries out for settlement. The U. S. Supreme Court has the power and the duty to establish one standard of patentable invention throughout the United States, and it should act now, and the instant case is a most suitable vehicle to lay down the law since the First Circuit Court has definitely stated that it has followed to the best of its ability the "strict" standard, as it interprets it, in the *Cuno v. Automatic* case, *supra*, and will follow it until the "confusion in the law with respect to the nature of the question of patentable invention" is cleared up.

It is not the Courts alone that are confused. Articles endeavoring to interpret the *Cuno* case, *supra*, and later cases on what is the standard of patentable invention

are regularly appearing in the Journal of the Patent Office Society and in other publications. They show the greatest disagreement and uncertainty on this subject amongst members of the patent bar.

The petition for rehearing should be granted, and petition for certiorari allowed because of the great need to clear up the question of what constitutes patentable invention in the United States: which need the First Circuit Court of Appeals in the instant case has specifically pointed out.

Respectfully submitted,

HAROLD E. COLE,
Attorney for Plaintiff-Petitioner.

I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay.

HAROLD E. COLE,
Attorney for Plaintiff-Petitioner.